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08/848,439

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/848,439	05/08/97	LAVALLIE	GI5288A

EXAMINER: E

HM21/0720

LEGAL AFFAIRS
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ART UNIT	PAPER NUMBER
~~1642~~ 1642	

DATE MAILED: 07/20/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☑ Responsive to communication(s) filed on 4/20/98

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 30 ~~month(s), or~~ thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☑ Claim(s) 1-26 is/are pending in the application.
Of the above, claim(s) 11-13 + 18-26 is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☐ Claim(s) _____ is/are rejected.
☐ Claim(s) _____ is/are objected to.
☑ Claim(s) 1-10 + 14-17 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.
☐ received in Application No. (Series Code/Serial Number) _____.
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

1. The Election filed April 20, 1998 (Paper No. 9) in response to the Office Action of March 18, 1998 (Paper No. 8) is acknowledged and has been entered. Claims 1-26 are pending in the application and claims 11-13 and 18-26 have been withdrawn from further consideration by the examiner under 37 CFR 1.142(b) as being drawn to non-elected inventions. Claims 1-10 and 14-17 are currently under prosecution.

2. Applicant's election with traverse of Group I, claims 1, 3, 5, 7-10 and 14-16 and species (a) in Paper No 9 is acknowledged. The traversal is on the ground(s) that the inventions I-III have not be shown to be distinct and the examination of all groups would not impose a serious burden on the examiner. The argument is persuasive as drawn to Groups I and II and therefore the restriction requirement between Groups I and II is withdrawn. However, as drawn to Groups I and III, the argument is not found persuasive because the groups have been shown to be distinct for the reasons disclosed in Paper No. 8 page 3. The inventions of Groups I and III are distinct because they are disclosed as biologically and chemically distinct, made by and used in different methods. In addition, the literature search, particularly relevant in this art, is not coextensive and therefore different searches and issues are involved in the examination of each group. Applicant further argues that the election of species requirement for claims 1, 2 and 18 is improper because the nucleotide species encode functional human SDF-5 proteins and the Code of Federal Regulations and the MPEP explicitly state that the presence of a linking generic claim prevents restriction, even if otherwise proper and Applicant cites 37 CFR 1.141 and MPEP 809.03. The arguments have been noted but have not been found persuasive because, a review of 37 CFR 1.141 reveals that the rule is drawn to

national applications and the instant application is not a national application and further, a review of MPEP 809.03 reveals that the section is drawn specifically to linking claims wherein the application has claims to two or more properly divisionable inventions but presented in the same case are one or more claims that are inseparable from the divisionable invention because they are genus claims linking species. However, claim 1 recites a markush group of 18 different nucleotide species with no genus claim linking the species, claim 2 recites 9 different nucleotide species with no genus claim linking the species and claim 18 recites two different amino acid sequences with no genus claim linking the species. MPEP 809.03 specifically states that a genus claim is one that is in addition to and inseparable from the species and thus links together inventions otherwise divisible. Since there are no genus claims linking the species claims the argument has not been found persuasive. Applicant further argues that the claims of Groups IV, VI and VII should be examined together because they are not distinct and would not impose a serious burden of search. The arguments have been noted but have not been found persuasive because the groups have been shown to be distinct for the reasons disclosed in Paper No. 8, page 3 and further the literature search, particularly relevant in this art, is not coextensive and therefore different searches and issues are involved in the examination of each group. For these reasons the restriction requirement is deemed to be proper and is therefore made FINAL.

3. Upon the withdrawal of restriction requirement between Group I and Group II, restriction to one of the following inventions is required under 35 U.S.C. § 121:

The invention is further subject to election of a single disclosed species.

Claims 1 and 2 are generic to a plurality of disclosed patentably distinct

species comprising structurally different isolated DNA sequences comprising (a) the elected sequence of species (a) of claim 1 (claim 1) and the SEQ ID NO: 2 as drawn to the elected sequence of species (a) of claim 1 (claim 2) and (b) SEQ ID NO:3 (claim 2). Claims 3-10 and 14-17 will be examined as they are drawn to the elected species.

4. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f)

or (g) prior art under 35 U.S.C. § 103.

7. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Ungar, PhD whose telephone number is (703) 308-305-2181.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lila Feisee, can be reached at (703) 308-2731. The fax phone number for this Art Unit is (703) 308-4065.

Communications via Internet e-mail regarding this application, other than those under 35 USC 132 or which otherwise require a signature may be used by the applicant and should be addressed to lila.feisee@uspto.gov.

All internet e-mail communications will be made of record in the application file. **PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of USC 122.** This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Effective, February 7, 1998, the Group and/or Art Unit location of your

application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1642.

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Donald E. Adams, Ph.D., Supervisory Patent Examiner at Donald.Adams@uspto.gov or 703-308-0570. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

Susan Ungar
July 15, 1998

LILA FEISEE
SUPERVISORY PATENT EXAMINER